

Remarks

[Each of the applicant's comments below is preceded by related statements in the action dated May 5, 2008, quoted in small, bold type.]

Claims 1-11, and 13-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1 the phrase "providing a consistency-maintaining food product having a gravity flowability" is rejected as the metes and bounds of the claims are unattainable due to the parameters being undefined. For example, it is unclear at what temperature the food product is being provided, i.e. room temperature, in a heated environment, or in a cooled or frozen environment as the environment directly affects whether the food product is provided is at a consistency-maintaining state which is capable of a gravity flowable state, in a gravity flowable state, or if the product to be delivered is in a consistency-maintaining state and has a gravity flowability at the time of printing.

With respect to claim 1 the phrase "applying a jettable media to the food product" is rejected as the phrase "the food product" on lines 3 and 6 of claim 1 lacks antecedent basis and thus it is unclear if the food product which is provided is at a consistency-maintaining state which is capable of a gravity flowable state, in only a gravity flowable state, or if the product to be delivered is in a consistency-maintaining state and has a gravity flowability.

With respect to claim 27 the phrase "providing a food product having a gravity flowability" is rejected as it is unclear if the food product is provided in a gravity flowable state, or if the product is capable of a gravity flowable state by providing a specific environment.

The phrase "at room temperature" in claims 17, 24, is rejected, as it is a relative term, which renders the claim indefinite. The term "at room temperature" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear as to what is encompassed by the phrase "at room temperature"; it is unclear as to what degree of difference is encompassed by this phrase, since a walk-in freezer would have one room temperature which is different from the room temperature of a heated environment.

The applicant has amended claims 1 and 27 to recite that the jettable media is applied while the food product is in a flowable state in which the flowability of the food product under the influence of gravity or the density of the food product is maintained consistently.

With respect to claims 17 and 24, a person of ordinary skill in the art would understand the meaning of room temperature as explained in Wikipedia, [http://en.wikipedia.org/wiki/Room\\_temperature](http://en.wikipedia.org/wiki/Room_temperature). "Room temperature (also referred to as ambient temperature) is a common term to denote a certain temperature within enclosed space at which humans are accustomed. Room temperature is thus often indicated by general human comfort, with the common range of 7°C (44°F) to 32°C (90 °F), though climate may acclimatize

people to higher or lower temperatures. The term can also refer to a temperature of food to be consumed, which is placed in such a room for a given time.”

Claims 1, 5-8, 10-11, 15-16, and 19-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willcocks et al. (WO01/94116).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that Willcocks et al. does not teach changing the state of the food product by reducing the gravity flowability thereof is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case, claims 1, 27 and 31 do not require that the product have gravity flowability prior to printing but that they merely have a capability of a "gravity flowability", and thus Willcocks et al. is relied upon to teach that the edible substrate is treated by "drying or fixing the image after the printing step", where it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom."

Amended claim 1 recites "applying a media to the food product ... while the food product is in the flowable state in which the flowability of the food product under an influence of gravity or the density of the food product is maintained consistently". Willcocks did not describe and would not have made obvious such features of amended claim 1. Willcocks' substrate for printing was in a solid and non-flowable state. The substrate had a shape that was planar, curved like the surface of an egg, a surface that includes grooves, ridges, or surfaces with other embossed or molded designs (page 24, line 23 to page 25, line 4). Although Willcocks mentioned once in his description that ice cream can also be used as a substrate (page 20, lines 15-17), Willcocks' discussion focused on printing on a solid, planar chocolate tablet (page 20, lines 16-17). It would have been obvious to one skilled in the art that the ice cream would have to be in a solid and non-flowable state because the methods described by Willcocks were only applicable to printing on solid and non-flowable substrates. Even if the ice cream was partially melted at the time of the printing, the ice cream was not in a flowable state "in which the flowability of the food product under an influence of gravity or the density of the food product is maintained consistently".

Therefore since Willcocks et al. teaches the claimed method, fixing the image after the printing step, in addition to teaching ice cream, where if not kept cool ice cream will melt, it would have been obvious to one of ordinary skill in the art to teach cooling the food product or that the food product is solidified in order to maintain the resolution of the image since the melted material would cause the ink to "run" or "bleed" and this in the instance case the "fixing step" is taken to mean cooling or freezing to a specific temperature in order to keep the ice cream from melting ...

In the instant case, one of ordinary skill in the art would view that the "fixing step" could be meant to represent cooling or freezing to a specific temperature in order to keep the ice cream from melting and/or providing it in its well known consumed form of a solid. Therefore since printing on ice cream, where if not kept cool ice cream will melt. In addition, cooling would allow the product to solidify, thereby allowing the image to maintain its high resolution since the melted material is in a set state due to lower the temperatures which lowers the surface energy as is taught by Willcocks et al. (pg. 22 line 24+). Thus it would have been obvious to one of ordinary skill in the art to teach cooling the food product or that the food product is solidified in order to maintain the resolution of the image since the melted material would cause the ink to "run" or "bleed" and thus in the instant case the "fixing step" is taken to mean cooling or freezing to a specific temperature in order to keep the ice cream from melting, or the product or coating from "running" or "bleeding".

Willcocks also did not describe and would not have made obvious "processing the food product to reduce the flowability of the food product under the influence of gravity". As explained earlier, Willcock's substrate was solid and non-flowable, and therefore, Willcocks would not even need to "reduce the flowability of the food product". In addition, contrary to the examiner's assertion that "the edible substrate is treated by "drying or fixing the image after the printing step"", Willcocks did not treat the substrate but only treated the jetted ink on the substrate so that the ink dries rapidly on the surface of the solid substrate (page 22, lines 19-22). Although Willcocks described changing the temperature of a chocolate substrate, such a change was not to "reduce the flowability of the food product" but was to change the surface energy of the solid chocolate substrate to reduce the tendency of printed ink to spread across the solid chocolate surface (page 22, lines 24-28).

Amended claim 1 is patentable over Willcocks. Amended claim 27 is patentable over Willcocks for at least reasons similar to those discussed with respect to amended claim 1.

Independent claim 31 and its dependent claims have been canceled.

Claims 5-8, 10-11, 15-16, 19-26, 28-30, and 37-40 are patentable for at least the reasons discussed with respect to claims 1 and 27, from which they depend.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willcocks et al. (WO01/94116) in view of Young (6536345).

Claims 9, 13, 14, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willcocks et al. (WO01/94116) in view of Young (6536345) and further in view of Baker et al. (5938826).

Claims 2-4, 9, 13-14, and 17-18 are patentable for at least the reasons discussed with respect to claim 1, from which they depend.

All of the dependent claims are patentable for at least similar reasons as those for the claims on which they depend are patentable.

Canceled claims have been canceled without prejudice or disclaimer.

Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.

The required extension fee in the amount of \$490 is being paid concurrently on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to deposit account 06-1050, referencing attorney docket 09991-133001.

Date: \_\_\_\_\_

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Respectfully submitted,



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